

REMARKS

The typographical errors in the specification noted by the Examiner have been corrected, and withdrawal of the objection with respect thereto is respectfully requested. In addition, document numbers have been inserted into the Cross Reference to Related Application Section as
5 required by the Examiner.

Claims 1-5 and 7-24 are now pending in the application. Claims 1-20 and 22-24 were rejected in view of the prior art of record, and claim 21 was indicated as being allowable if rewritten in independent form.

By the present Amendment, independent claims 1, 8, 15, and 23 have been amended and
10 claim 6 has been canceled. Claim 7 has been amended to depend from Claim 1. Applicant believes claims 1-5 and 7-24 patentably distinguish over the references and are allowable in their present form, and respectfully requests reconsideration in view of the above amendments and the following comments.

Claims 1-2 and 6-8 were rejected under 35 U.S.C. 103(a) as being unpatentable over
15 Sekendur (U.S. Patent No. 5,852,434), second embodiment. Claims 3, 4, and 15 were rejected under 35 U.S.C. 103(a) as being unpatentable over Sekendur as applied to claim 1, and further in view of Lazzouni et al. (U.S. Patent No. 5,652,412); and claims 1, 3, 5, 8, 15-17, and 23 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lazzouni et al., in view of Sekendur, first and second embodiments. In addition, claims 9-11 and 13-14 were rejected under 35 U.S.C.
20 103(a) as being unpatentable over Sekendur as applied to claim 8, and further in view of Wolff et

al. (U.K. Patent Application No. GB 2306669A); and claims 9-15, 17-20 and 22-24 were rejected under 35 U.S.C. 103(a) as being unpatentable over Lazzouni et al., in view of Sekendur and Wolff et al.

5 Claim 1, as amended, is directed to an electronic reading device that comprises an optical detector for detecting positional data for the electronic reading device with respect to an address pattern of a specially formatted surface. Additionally, the electronic reading device comprises a sensor for sensing whether the electronic reading device is in contact with the specially formatted surface, wherein the detection of positional data by the optical detector is enabled at least when the sensor determines that the electronic reading device is in contact with the specially formatted
10 surface.

In addition, independent claim 1 has been amended herein to include subject matter recited in originally filed claim 6 which has now been cancelled. Specifically, claim 1 now also recites that the sensor comprises a force sensitive detector for sensing whether the electronic reading device is in contact with the specially formatted surface.

15 The Sekendur reference discloses the use of a surface formatted with position-related coding means for indicating X-Y coordinates capable of reflecting a frequency of light. The stylus (pen) has a light source for illuminating the surface, and light reflected back into the stylus from the surface impinges onto a charge-coupled device (CCD) located within the stylus. Received information is sent to a computer for processing and is output to a user.

20 The stylus is composed of a pen-shaped optical conduit. At the lower scanning end is a replaceable and/or retractable writing element connected to a pressure sensitive on/off switch. A

microcomputer is also located within the stylus which interfaces the CCD chip and other components. The upper end of the stylus comprises a wireless transmitter for communicating with other devices.

In the Office Action, the Examiner considers that pressure sensitive on/off switch 10 of
5 Sekendur corresponds to the sensor of Claim 1. In this regard, the Examiner concedes that Sekendur does not disclose the function of switch 10, but contends "[h]owever, it is clear that it would be turned on when writing due to writing element 9 contacting the surface of FIG. 1". Applicant respectfully disagrees with the Examiner's conclusions regarding switch 10.

Applicant submits that there is no teaching or suggestion in the Sekendur reference to lead
10 one to believe that the operation of switch 10 is in any way related to whether or not the writing element 9 is in contact with a writing surface. To the contrary, Applicant believes that any suggestion in Sekendur as to the possible function of switch 10 is that it does not serve that function.

For example, Applicant suggests that a more likely purpose of switch 10 is as a button that
15 is operated by the user to extend or retract the writing element. Specifically, a user could press the pressure-sensitive switch to extend the writing element, and press it again to retract the writing element. Applicant believes that this is a very possible use of the switch because in both the Fig. 6 and Fig. 7 embodiments, the switch is located on the outside of the conduit 8 where it is easily accessible to be pressed by a user.

20 Furthermore, in Fig. 7, the switch is shown as being connected to writing element 9 (as is also indicated in the description), however, the drawing does not show (nor does the disclosure

describe) the switch as being connected, in any way, to the light source of the stylus, which would appear to be necessary if the switch controlled the operation of the light source.

Applicant, accordingly, believes that the Examiner's interpretation of the function of switch 10 is unsupported by the disclosure in Sekendur, and that, if anything, Sekendur teaches
5 away from the Examiner's interpretation.

Sekendur simply does not disclose or suggest a pressure sensitive on/off switch that functions as a sensor comprising a force sensitive detector for sensing whether the electronic reading device is in contact with the specially formatted surface as recited in Claim 1.

Accordingly, Applicant believes that Claim 1 patentably distinguishes over the reference and is
10 allowable in its present form..

Independent claims 8, 15 and 23 have been amended in a manner similar to claim 1 and should also be allowable in their present form.

Claims 2-5, 7, 9-14, 16-22 and 24 depend from and further restrict the independent claims, and should also be allowable in their present form. In rejecting many of the dependent claims, the
15 Examiner has applied Lazzouni et al. and Wolff et al. in addition to Sekendur. Lazzouni, et al. generally describes an information recording apparatus for use with paper having a prerecorded pattern of pixels associated with a writing surface. Each of the pixels contains encoded, optically readable position information that identifies an absolute coordinate position on the writing paper. The information recording apparatus comprises a pen to write on the encoded paper, wherein the
20 position of the pen tip is determined by reading the pattern of pixels and storing the position information in the recording unit. Furthermore, the Wolff et al. reference discloses strain gauges

connected to the shaft of a pen tip to record the forces applied to the tip by measuring the force exerted on four pairs of orthogonal strain gauges. Wolff et al. discloses position and pressure sensors to determine location within a page.

Neither Lazzouni et al. nor Wolff et al. supply the deficiencies in Sekendur. With respect
5 to Lazzouni et al. the Examiner contends that the reference refers to detecting a pen on paper, but concedes the reference does not disclose a switch or any other means for the detection. Certainly, neither Sekendur (as discussed above) nor Lazzouni et al. discloses or suggests a sensor comprising a force sensitive detector for sensing the contact.

Wolff et al. does not relate to optical detection of positional data. Also, Wolff et al. is
10 silent with regard to a sensor comprising a force sensitive detector for sensing whether an electronic reading device is in contact with the specially formatted surface.

Applicant, accordingly, believes the claims also patentably distinguish over any reasonable combination of the three cited references.

Many of the dependent claims also recite additional features which are not disclosed or
15 suggested by the references. For example, as recognized by the Examiner with respect to claim 21, the references do not teach using the electronic reading device to select a particular location on the specially formatted surface by pressing against the surface with a force above a predetermined threshold. Applicant believes that claim 7 should be allowable for this reason as well.

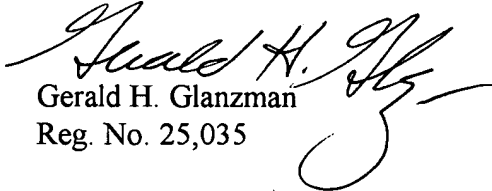
20 In view of all the above, it is believed that this application is in condition for allowance, and it is respectfully requested that the Examiner so find and issue a Notice of Allowance in due

course.

For the convenience of the Examiner, a marked-up copy of the amended specification paragraphs is attached as EXHIBIT A, a marked-up copy of the amended claims is attached as EXHIBIT B and a clean copy of all the claims in the case is attached as EXHIBIT C..

Respectfully submitted,

JENKENS & GILCHRIST,
A Professional Corporation


Gerald H. Glanzman
Reg. No. 25,035

1445 Ross Avenue, Suite 3200
Dallas, Texas 75202-2799
(214) 965-7343
(214) 855-4300 (fax)

EXHIBIT A
MARKED UP SPECIFICATION

Please replace the paragraph beginning at page 1, line 9 and ending on page 3, line 21 with the following rewritten paragraph.

The present application for patent is related to and hereby incorporates by reference the subject matter disclosed in U.S. Patent Application Serial Nos. 09/703,497 (Attorney Docket No.34650-566PT), entitled "Specially Formatted Paper Based Applications of a Mobile Phone"; 09/703,503 (Attorney Docket No.34650-569PT), entitled "Method and System for Using an Electronic

5 Reading Device as a General Application Input and Navigation Interface"; 09/703,704 (Attorney Docket No.34650-578PT), entitled "Predefined Electronic Pen Applications in Specially Formatted Paper"; 09/703,506 (Attorney Docket No. 34650-579PT), entitled "A System and Method for Operating an Electronic Reading Device User Interface"; 09/703,325 (Attorney Docket No. 34650-601PT), entitled "Method and System for Using an Electronic Reading Device

10 on Non-paper Devices"; 09/703,486 (Attorney Docket No. 34650-602PT), entitled "Multi-layer Reading Device"; 09/703,351 (Attorney Docket No. 34650-604PT), entitled, "Method and System for Configuring and Unlocking an Electronic Reading Device"; 09/703,485 (Attorney Docket No. 34650-606PT), entitled "Printer Pen"; 09/703,492 (Attorney Docket No. 34650-607PT), entitled "Method and System for Electronically Recording Transactions and Performing

15 Security Function"; 09/703,480 (Attorney Docket No. 34650-654PT), entitled "Method and System for Handling FIFO and Position Data in Connection with an Electronic Reading Device";

09/703,479 (Attorney Docket No. 34650-655PT), entitled "Hyperlink Applications for an Electronic Reading Device"; 09/703,464 (Attorney Docket No. 34650-656PT), entitled "Measuring Applications for an Electronic Reading Device"; 09/703,321 (Attorney Docket No. 34650-657PT), entitled "Method and System for Controlling an Electronic Utility Device Using an Electronic Reading Device"; and 09/703,481 (Attorney Docket No. 34650-658PT), entitled "Positioning Applications for an Electronic Reading Device"; and 09/703,326 (Attorney Docket No. 34650-673PT), entitled "Method for Sharing Information Between Electronic Reading Devices"; and in U.S. Provisional Patent Application Serial Nos. 60/244,775 (Attorney Docket No. 34650-671PL), entitled "Electronic Pen for E-Commerce Implementations"; and 60/244,803 (Attorney Docket No. 34650-672PL), entitled "Electronic Pen Help Feedback and Information Retrieval"; all filed concurrently herewith.

Please replace the paragraph beginning at page 19, line 10 and ending on page 20, line 10, with the following rewritten paragraph:

--Referring now to FIGURES 3 through 6 there are illustrated various examples of protocol stacks that can be used for communicating between the entities shown in FIGURE 2. Generally, however, such protocols apply [however] only if the two communicating entities are implemented in different devices. If two or more entities are combined into one device, a proprietary protocol can be used to communicate between the entities. FIGURE 3 illustrates the protocol stacks that can be used in the case of local communications (e.g., using Bluetooth™) between the electronic pen 10 and the electronic pen client 22. If, on the other hand, the electronic pen 10 and the

electronic pen client 22 communicate with one another via an Internet connection, the protocol stacks depicted in FIGURE 4 will be used. FIGURE 5 illustrates a protocol stack for communicating between the electronic pen client and each of the supporting entities, such as the name server 26, the control node 24, the base translator 28, and the application server 30, when
5 the electronic pen client 22 is not contained within a server on the Internet (e.g., such as when the electronic pen client 22 is located in a mobile phone 14). Finally, FIGURE 6 depicts the protocol stacks that are used when the electronic pen client 22 is located on the Internet.--

Please replace the paragraph beginning at page 22, line 1 and ending on page 22, line 21, with the following rewritten paragraph:

--Another similar message is the empty grid description with a grid exception. When the electronic pen 10 requests a new grid description from the electronic pen client 22, the electronic pen client 22 uses the detected position specified in the request to ask the name server 26 for a URL where the application description can be found. If no URL is returned, the electronic pen
5 client 22 can send an empty grid description with a grid exception to the electronic pen 10. The grid exception comprises a rectangle or other shape indicating the area around the detected position where no registered applications can be found. Preferably, the indicated area is as large as possible so that the electronic pen 10 and/or electronic pen client 22 know the extent of the surrounding area that is unassigned and do not have to repeatedly send requests to the name
10 server 26. Thus, the empty grid description with a grid exception causes the electronic pen 10 to unload its current grid and also informs the electronic pen 10 of an area surrounding the detected

position that can essentially be ignored because [its] it is not associated with any application.--

EXHIBIT B
MARKED UP CLAIMS

1 1. (Amended) An electronic reading device, comprising:

2 an optical detector for detecting positional data for the electronic reading device
3 with respect to an address pattern of a specially formatted surface; and
4 a sensor comprising a force sensitive detector for sensing whether the electronic
5 reading device is in contact with the specially formatted surface, wherein the detection of
6 positional data by the optical detector is enabled at least when the sensor determines that the
7 electronic reading device is in contact with the specially formatted surface.

1 6. (Cancel)

1 7. (Amended) The electronic reading device of claim [6]1, wherein the sensor detects a
2 user selection of a location on the address pattern in response to a detection of contact between
3 the electronic reading device and the specially formatted surface greater than a predetermined
4 threshold force.

1 8. (Amended) A system for electronic entry of information, comprising:

2 a specially formatted surface including an address pattern, wherein a particular
3 position on the address pattern can be determined based on an examination of only a portion of
4 the address pattern; and

5 an electronic reading device including:

6 an optical detector for detecting a portion of the address pattern adjacent
7 to the electronic reading device;

8 a sensor comprising a force sensitive detector for detecting contact
9 between a tip of the electronic reading device and the specially formatted surface; and
10 a processor for receiving the positional data and determining a particular
11 position of the electronic reading device relative to the address pattern when the sensor
12 detects contact between a tip of the electronic reading device and the specially formatted
13 surface.

1 15. (Amended) A method for using an electronic reading device, comprising the steps of:
2 sensing whether the electronic reading device is contacting a specially formatted
3 surface using a touch sensor, wherein said touch sensor comprises a force sensitive detector;
4 detecting positional data for the electronic reading device relative to an address
5 pattern of the specially formatted surface; and
6 storing the positional data when the touch sensor detects that the electronic
7 reading device is contacting the specially formatted surface.

1 23. (Amended) An electronic reading device, comprising:
2 an optical detector for detecting positional data for the electronic reading device
3 with respect to an address pattern of a specially formatted surface;
4 a sensor comprising a force sensitive detector for sensing whether the electronic
5 reading device is in contact with the specially formatted surface, wherein the detection of
6 positional data by the optical detector is enabled at least when the sensor determines that the
7 electronic reading device is in contact with the specially formatted surface; and

8 writing means for writing on surfaces, wherein the writing means can be selectively
9 activated and deactivated, the optical detector capable of detecting positional data whether the
10 writing means is activated or deactivated.